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28 VISA U.S.A. INC. and
VISA INTERNATIONAL SERVICE ASSOCIATION

19 UNITED STATES DISTRICT COURT
20 NORTHERN DISTRICT OF CALIFORNIA
21 OAKLAND DIVISION

22 SAFECCLICK, LLC, an Iowa
23 limited liability company

24 Plaintiff,

Case No.: C03-05865 SBA ADR

25 **JOINT CLAIM CONSTRUCTION
26 STATEMENT**

27 v.

28 VISA U.S.A. INC., a Delaware corporation, and
VISA INTERNATIONAL SERVICE
ASSOCIATION, a Delaware corporation

Defendants.

1 **JOINT CLAIM CONSTRUCTION AND PREHEARING STATEMENT**

2 Pursuant to Patent Local Rule 4-3, Plaintiff Safeclick , LLC and Defendants Visa
3 International Service Association and Visa U.S.A. Inc. (collectively, "Visa") together
4 submit the following Joint Claim Construction and Prehearing Statement concerning U.S.
5 Patent No. 5,793,028 ("the '028 patent").

6 **I. Preliminary Matters**

7 **A. Length of Time Needed For Hearing**

8 The parties estimate that 4 hours (2 hours for Plaintiff and 2 hours for Visa) will be
9 required for a claim construction hearing.

10 **B. Witnesses at the Hearing**

11 The parties agree that no witnesses will be called at the claim construction hearing.

12 **C. Issues Appropriate At A Prehearing Conference**

13 The parties agree that no prehearing conference is required.

14 **D. Identification of Intrinsic Evidence Generally**

15 The parties will rely upon the following documents as intrinsic evidence for claim
16 construction purposes:

- 18 1. The '028 patent;
- 19 2. the prosecution history for the '028 patent;
- 20 3. documents referenced in the specification of the '028 patent; and
- 21 4. patents cited by the applicants or examiners of the U.S. application, which
22 include:
 - 23 a. U.S. Patent No. 4, 614,861;
 - 24 b. U.S. Patent No. 5,130,519;
 - 25 c. U.S. Patent No. 5,237,609; and,
 - 26 d. U.S. Patent No. 5,559,887.

1 **E. Identification of Extrinsic Evidence Generally**

2 The parties may rely upon the following extrinsic evidence for claim construction
3 purposes, with specific citations provided herein. The parties may also rely upon
4 declarations of experts regarding how one of skill in the art would understand the disputed
5 claim terms as of the filing date of the '028 patent application. It is the intent of the parties
6 to identify, below, all of the extrinsic evidence referenced in the documents attached hereto,
7 but if, by oversight, a reference is missed, it is the parties intent that such references be
8 added to the list.

- 9 1. Webster's Encyclopedic Unabridged Dictionary, 1989 ed.;
- 10 2. McGraw-Hill Dictionary of Scientific and Technical Terms, 5th ed., 1994;
- 11 3. Microsoft Computer Dictionary, 5th ed., 2002;
- 12 4. The American Heritage Dictionary of the English Language, Houghton
13 Mifflin Co., 1975;
- 14 5. Webster's New Collegiate Dictionary, Simon & Schuster, Inc., 1974;
- 15 6. *Internet Protocol, DARPA Internet Program Protocol Specification*, dated
16 September 1981;
- 17 7. *Interchange Message Specification for Debit and Credit Card Message
18 Exchange among Financial Institutions*. ANSI X9.2-1988;
- 19 8. *Financial Institution Retail Message Authentication*, American National
20 Standards Institute, May 7, 1996;
- 21 9. U.S. Patent No. 4,755,940 to Bracht;
- 22 10. U.S. Patent No. 5,017,766 to Tamada, et al.;
- 23 11. U.S. Patent No. 5,426,281 to Abecassis;
- 24 12. U.S. Patent No. 5,343,529 to Goldfine, et al.;
- 25 13. U.S. Patent No. 5,420,926 to Low, et al.;
- 26 14. U.S. Patent No. 5,621,797 to Rosen;
- 27 15. U.S. Patent No. 5,671,279 to Elgamal;

16. U.S. Patent No. 5,684,950 to Dare, et al.;
17. U.S. Patent No. 5,708,422 to Blonder, et al.
18. U.S. Patent No. 5,715,314 to Payne;
19. U.S. Patent No. 5,724,424 to Gifford;
20. U.S. Patent No. 5,757,917 to Rose et al.;
21. U.S. Patent No. 5,809,144 to Sirbu, et al.;
22. U.S. Patent No. 5,815,665 to Teper;
23. U.S. Patent No. 5,822,737 to Ogram;
24. U.S. Patent No. 5,825,881 to Colvin;
25. U.S. Patent No. 5,826,241 to Stein et al.
26. U.S. Patent No. 5,826,245, to Sandberg-Diment; and
27. U.S. Patent No. 5,897,621 to Boesch.

13 **II. Introduction To Claim Constructions**

14 Discovery related to claim construction matters is ongoing and not scheduled to close
15 until October 1, 2004. Consequently, the parties consider these claim constructions to be
16 preliminary and reserve the right to refine or revise their respective claim construction
17 positions when claim construction opening briefs are submitted simultaneously on October
18 13, 2004.

19 In accordance with Patent Local Rule 3-3, Visa has submitted to Plaintiff its
20 Preliminary Invalidity Contentions in which Visa has identified how the asserted claims of
21 the '028 patent are invalid under 35 U.S.C. § 112 for being indefinite. Visa renews its
22 contentions of invalidity. By proposing claim constructions for the disputed claim terms,
23 Visa does not waive or concede its invalidity contentions due to 35 U.S.C. § 112 defects.

24 The following claim constructions are limited to claims 6 and 7 which are the claims
25 asserted in the case.

26 Generally speaking, except where specifically noted, the parties believe that similar
27 claim terms should be construed consistently across all claim elements. That is, once a
28

1 claim term is construed when it first appears, it can generally be applied consistently where
2 it appears throughout the remaining claim elements.

3 **III. Stipulated Claim Constructions**

4 The parties have met and conferred in order to reduce the number of claim terms in
5 dispute for which the parties request the Court to provide a construction. As a result of this
6 dialogue, the parties have reached agreement on and hereby stipulate to the following claim
7 term constructions to be applied consistently across all claims where the terms appear.

8 ***Order of Steps.*** The parties agree that the steps of the methods recited in claims 6
9 and 7 must be accomplished in the recited order.

10 ***Computer*** means *a system or systems, such as a dedicated system or systems, a general*
11 *purpose computer system, or distributed processing system, which is able to embody and/or execute*
12 *the logic of the processes, embodied in the form of software instructions or firmware, described for*
13 *the transactionor, transactionee and verifier, and which is capable of being assigned a public*
14 *identification code that uniquely identifies it.*

15 ***Transactionor*** means *an individual, company or other entity, desiring to execute or*
16 *initiate an Electronic Transaction such as ordering an item from a Transactionee, or transferring*
17 *money from the Transactionor's savings account to the Transactionor's checking account or*
18 *transferring money from the Transactionor's account in the Transactionee's bank to another*
19 *account in another bank, or transferring other information requiring reliable traceable*
20 *communications, such as transferring patient care instructions from a medical practitioner to a*
21 *nursing entity within a hospital environment.*

22 ***Transactionee*** means *an individual, company or other entity which can be requested to*
23 *execute, process or deliver an Electronic Transaction, including systems where the action triggered*
24 *by receipt of the Electronic Transaction is action at a distance via some other communication*
25 *method.*

26 ***Verifier*** means *an individual, company or other entity which can embed, or can*
27 *communicate with systems which embed the information and/or processes required to validate*
28 *transactions together with the procedural capability to perform such validation.*

1 ***Electronic transaction*** means a transaction between two parties, a Transactionor and a
2 Transactionee, which is requested and/or transmitted and/or delivered and/or executed
3 electronically.

4 ***Executing the electronic transaction*** means concluding the electronic transaction by
5 performing the remaining business steps to accomplish the goals of the parties to the transaction.

6 ***Automatically*** means functioning without intervention by a human operator.
7

8 **IV. Claim Terms Remaining In Dispute**

9 The parties dispute the proper construction for six terms as summarized in Table 1.
10 The disputed terms appear in both claim 6 and 7. For reference, claim 6 is reproduced
11 below with each disputed term indicated in bold where it first appears in the claim.

12 6. A method comprising the steps of:

13 **transmitting** a transaction initiation request requesting the initiation
14 of an electronic transaction **to** a transactionee computer **from** a transactionor
15 computer, the transaction initiation request **including** a **public identification**
16 **code uniquely identifying the transactionor computer**, and a public
17 identification code uniquely identifying a transactionee computer;

18 receiving by the transactionee computer the transaction initiation
19 request;

20 transmitting a verification request requesting verification of the
21 transaction from the transactionee computer to a verifier computer **in**
22 **response to** the transactionee computer receiving the transaction initiation
23 request, the verification request including one of a private identification code
24 and a public identification code uniquely identifying the transactionee
25 computer and the public identification code uniquely identifying the
26 transactionor computer;

27 receiving the verification request by the verifier computer
28

1 transmitting an acknowledgement request requesting
2 acknowledgement of the electronic transaction from the verifier computer to
3 the transactionor computer in response to the verifier computer receiving the
4 verification request;

5 receiving the acknowledgement request by the transactionor
6 computer;

7 transmitting an acknowledgement response **indicating one of a valid**
8 **electronic transaction and an invalid electronic transaction** from the
9 transactionor computer to the verifier computer in response to the
10 transactionor computer receiving the acknowledgement request, the
11 acknowledgement response including **the private identification code**
12 **uniquely identifying the transactionor computer**;

13 receiving the acknowledgement response by the verifier computer;

14 transmitting a verification response indicating one of a valid
15 electronic transaction and an invalid electronic transaction from the verifier
16 computer to the transactionee computer in response to the verifier computer
17 receiving the acknowledgement response; and

18 receiving the verification response by the transactionee computer and
19 executing the electronic transaction in response to the transactionee
20 computer receiving the verification response indicating a valid electronic
21 transaction.

1
2
3 **Table 1**
4
5
6

7 Term In Dispute	8 Safeclick Construction	9 Visa Construction
10 Transmitting ... to ... from / 11 transmitting ... from ... to	12 Moving or sending information 13 or data from one location to 14 another directly or indirectly.	15 Sending, via any 16 communication link, from the 17 sender (e.g., from the source 18 address) to the receiver (e.g., to 19 the destination address) and not 20 through any other party
21 Including	22 Containing.	23 Containing within the body of 24 the transmission
25 Public identification code 26 uniquely identifying the 27 transactionor computer	28 A code that singularly 29 identifies the transactionor 30 computer for the duration of 31 the electronic transaction, 32 which code all parties to the 33 electronic transaction may view 34 or have knowledge of.	35 A publicly available label that 36 provides one-of-a-kind 37 identification of the computer 38 used by the transactionor, but 39 not of the transactionor 40 himself/herself
41 In response to	42 In reply or reaction to.	43 In reply to, and on the basis of 44 information received in, a 45 previously received message; 46 in this element, in reply to and 47 on the basis of the information 48 contained in the transaction 49 initiation request
50 Indicating one of a valid 51 electronic transaction and an 52 invalid electronic transaction	53 Implying or showing a sign of 54 whether the transaction is 55 authoritative or not, for 56 example (but not limited to) by 57 means of a password entered 58 into or stored within the 59 Transactionor Computer.	60 Signifying that the electronic 61 transaction is either (1) binding 62 or (2) not binding on the 63 transactionor
64 The private identification code 65 uniquely identifying the 66 transactionor computer	67 The code that singularly 68 identifies the transactionor 69 computer for the duration of 70 the electronic transaction, such 71 code being known or 72 accessible only to a particular 73 trusted person or group.	74 A one-of-a-kind and non-public 75 identifier of the computer used 76 by the transactionor, but not of 77 the transactionor him/herself

25
26 Plaintiff's proffered constructions, along with supporting intrinsic and extrinsic
27 evidence are presented in Attachment A hereto. Similarly, Visa's proffered constructions,
28

1 along with supporting intrinsic and extrinsic evidence, are presented in Attachment B
2 hereto.

3

4 DATED: September 3, 2004

5

6 Respectfully Submitted,

7

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